

REMARKS

This Response is being filed in connection with the Final Office Action mailed December 15, 2004. Claims 16 to 25 are pending. Claims 16 to 18, 22, 24 and 25 have been cancelled herein without prejudice. Applicants maintain the right to prosecute the cancelled claims in any related application claiming the benefit of priority of the subject application. Accordingly, upon entry of the Response claims 19 to 21 and 23 are under consideration.

Applicants thank the Examiner for the Interview held on February 15, 2005, in which a proposed amendment to overcome all outstanding rejections of record was discussed. This Response is consistent with the proposed amendment and subsequent discussion. In addition, the Response places the claims in better form for allowance or for consideration upon appeal.

Regarding the Claim Amendments

Claims 19 and 20, which previously depended from claim 18, have been amended herein to depend from claims 21 and 23. The amendment was necessitated by the cancellation of claim 18. Thus, as the amendments to the claims were made to address various informalities, no new matter has been added. In addition, the amendments place the claims in better form for allowance or for consideration upon appeal. Consequently, entry thereof is respectfully requested.

Regarding the Priority Claim

Applicants note that the Final Office Action acknowledges the grant of the Petition to award the subject application a March 20, 2001, filing date. Thus, because the subject application has a March 20, 2001, filing date, which was prior to the issuance of the patent from parent application serial no. 09/055,263, the claim of priority to application serial no. 09/055,263, filed April 6, 1998, under 35 U.S.C. §120 is proper.

I. REJECTIONS UNDER 35 U.S.C. §112, FIRST PARAGRAPH

The rejection of claims 18 to 20 and 22 under 35 U.S.C. §112, first paragraph, as allegedly lacking enablement is respectfully traversed. The grounds of rejection are of record.

Claims 18 to 20 and 22 are adequately enabled by the specification. In this regard, as pointed out in the record, claims 18 to 20 and 22 do not require treatment of a multiple sclerosis patient. In this regard, the claimed methods are directed to *predicting* therapeutic efficacy of such treatment. Thus, as treatment of a multiple sclerosis patient is not required, treatment of a multiple sclerosis patient need not be enabled. Consequently, the grounds for rejection due to the assertion that the specification allegedly does not adequately enable practicing a method of treatment is improper.

Nevertheless, solely in order to further prosecution of the application and without acquiescing to the propriety of the rejection, claims 16 to 18, 22, 24 and 25 have been cancelled herein without prejudice. As such, the rejection under 35 U.S.C. §112, first paragraph, is moot and should be withdrawn.

Ii. REJECTIONS UNDER 35 U.S.C. §112, SECOND PARAGRAPH

The rejection of claims 24 and 25 under 35 U.S.C. §112, second paragraph, as allegedly indefinite is respectfully traversed. The Examiner indicates that SEQ ID NO:2 as recited in the Sequence Listing allegedly is different from what is defined in claims 24 and 25.

Claims 24 and 25 are clear and definite as written because the skilled artisan would be apprised of the claimed subject matter. In particular, the sequences encompassed by claims 24 and 25 are adequately defined by the language of the claims such that they would be known to the skilled artisan without referencing the Sequence Listing. Consequently, the skilled artisan would be apprised of the subject matter of claims 24 and 25 and, therefore, claims 24 and 25 are clear and definite as written, and the rejection is improper.

Nevertheless, solely in order to further prosecution of the application and without acquiescing to the propriety of the rejection, claims 24 and 25 have been cancelled herein without prejudice. As such, the rejection under 35 U.S.C. §112, second paragraph, is moot and should be withdrawn.

CONCLUSION

In summary, for the reasons set forth herein, Applicants maintain that claims 19 to 21 and 23 clearly and patentably define the invention, respectfully request that the Examiner reconsider the various grounds set forth in the Office Action, and respectfully request the allowance of the claims now pending.

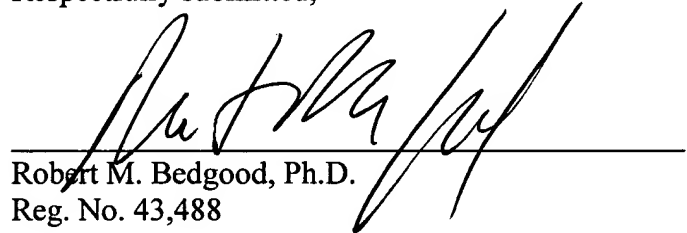
If the Examiner would like to discuss any of the issues raised in the Office Action, Applicant's representative can be reached at (858) 509-4065.

Please charge any additional fees, or make any credits, to Deposit Account No. 03-3975.

Respectfully submitted,

Date: _____

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